

**REMARKS**

**I. Status**

Claims 1-15 and 55-60 are pending.

Claims 1-15 and 55-69 stand rejected.

Claims 1, 3 -4, 6, 7 – 14, 15, 55 – 56, 58, 60-62, 64 – 66, 67 are amended.

Claims 16-54 are withdrawn without prejudice.

Claims 2, 57, 68-69 are requested cancelled herein.

**II. Rejection Under 35 USC §103(a)**

The Examiner rejected Claims 1-15 and 55-69 under 35 U.S.C. 103(a) as being unpatentable over Leatherman (U.S. Patent No. 5,544,044), in view of Johnson (USP No. 4,987,538). In support of the rejection, the examiner alleges that Leatherman disclosed a system comprising software accessed at a provider computer. But as the examiner states, "Leatherman does not explicitly disclose that the software adapted to prompt the provider to input data concerning a workers' compensation claim ... However, these features are known in the art as evidenced by Johnson. In particular, Johnson suggests the software adapted ... to produce an indication of the lack of the worker's compensation claim number (see Johnson col. 2, lines 1-67 to col. 3, line 49). It would be obvious ... to include the features of Johnson within the system of Leatherman for providing a method for processing provider billing ... is controlled by a detailed and complex array of administrative rules."

A claimed invention is *prima facie* obvious when three basic criteria are met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference or combined references must teach or suggest all the claim limitations.

The primary reference to Leatherman teaches a system and method for managing and processing insurance claims that implement a graphic user interface. However, the Leatherman system is not for “any type of claims” as asserted by the examiner. More specifically, as Leatherman states in the abstract, “A software-based medical information system performs a method of *analyzing health care claims* records for an enrolled population (e.g., HMO, Medicaid) *to assess and report on quality* of care based on conformance to nationally recognized medical practice guidelines or quality indicators. The system *analyzes health care* received by enrollees having a specified health care condition by: providing to the system health care claims records for a selected enrollee population; defining at least one health care condition in terms of health care events reportable in health care claims records; identifying in the health care claims records those enrollees meeting the definition for that health care condition; defining health care quality criteria for that health care condition in terms of health care events reportable in health care claims records; comparing the health care quality criteria for the at least one health care condition to the health care claims records for at least a portion of those enrollees meeting the definition for that health care condition; and developing and outputting from the system a health care quality report based on the comparison and formulating action recommendations to improve care. The system provides an efficient means to supplement claims data with data from patient medical records (*emphasis provided*).”

Thus, Leatherman essentially teaches a computerized method for a medical provider to assess and report on quality of care based on conformance to nationally recognized medical practice guidelines or quality indicators, which has nothing to do with verifying workers’ compensation claims.

Johnson discloses an automated processing system for payment of bills submitted by a provider by manually converting the bill information into computer readable format (see claim 1 col. 8, lines 10-15) and processing the converted bills in conjunction with administrative rules associated with a payer to determine a maximum payout for the submitted bill. Johnson begins from the position that the bill or the converted information includes a valid claim identification (“[a]n important first step that occurs in the qualifications of the claimant. That is, the claimant

is required to have an accepted claim ... and the treatment provided must be for an accepted condition." col. 2, lines 45-49). Hence, Johnson fails to disclose or suggest " the workers' compensation claims verification system automatically sends ~~is adapted to produce~~ an indication of the lack of determining the workers' compensation claim number to a selected one of a plurality of payer computers" as is recited in claim 1.

Given that Leatherman and Johnson are two distinct systems and that neither Leatherman nor Johnson discloses or suggests the essential elements of the invention as claimed, it is respectfully submitted that the present invention, as recited in claim 1, is not obvious in view of the references cited.

In view of the foregoing, applicant respectfully submits that the examiner has failed to show how one of ordinary skill in the art at the time of invention would have been motivated to combine the systems of Leatherman and Johnson to include the claimed verification.

Furthermore, even if the cited references were to be combined, the combined invention would fail to include all the elements of the invention claimed. As shown, the combined device would continue to fail to provide an indicator when the lack of a valid claim number is determined. Rather, each of the references assumes that the claim number is available and provides no teaching when a valid claim number is not available.

Accordingly, for this reason also, applicant respectfully submits that the examiner has failed to show how combined systems of Leatherman and Johnson would render obvious the present invention.

In Yamanouchi Pharmaceutical Co. v. Danbury Pharmacal, Inc., 231 F. 3d 1339, 56 USPQ2d 1641 (Fed. Cir. 2000), the court reflected on the importance of suggestion or motivation to combine references in an obviousness analysis by stating:

an examiner ... may often find every element of a claimed invention in the prior art. If identification of each claimed element of the prior art was sufficient to negate patentability, very few patents would ever issue. Furthermore rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner ... to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention ... To counter this potential weakness in the obviousness construct, the suggestion to

combine requirements stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness. Id. at 1644, quoting *In re Rouffet*, 149 F.3d 1350, 1357-58, 47 USPQ 2d 1453, 1457 (Fed. Cir. 1998)

Applicant has amended claim 1 to more clearly specify that the *system is adapted to produce and indication* is in fact provided when the *system automatically sends an indication*.

With regard to claims dependent from claim 1, these claims were rejected based in part on the same reason for rejecting claim 1. However, having shown that the present invention, as recited in claim 1, is non-obvious in view of the references cited, applicant submits that these dependent claims are also not obvious, and are allowable, by virtue of their dependence upon an allowable base claim.

With regard to independent claims 55 and 56, the examiner rejected these claims essentially citing the same references used in rejecting claim 1. The applicant has specified that *the rules are workers' compensation information* required to reconcile more specifically *workers' compensation billing*.

Accordingly, for the remarks made with regard to the rejection of claim 1, which are applicable to, and repeated as if in their entirety, to overcome the rejection of claims 55 and 56, applicant submits that claims 55 and 56 are also not obvious, and allowable, in view of the references cited.

With regard to claims dependent from claims 55 and 56, these claims were rejected based in part on the same reason for rejecting claims 55 and 56. The reference *to rules* in these claims has been replaced by a reference to *workers' compensation information*. Otherwise, having shown that the present invention, as recited in claims 55 and 56, is non-obvious in view of the references cited, applicant submits that these dependent claims are also not obvious, and are allowable, by virtue of their dependence upon an allowable base claim.

### **III. Claim Amendments**

Applicant has submitted amendments to the claims to more clearly state the invention. No new matter has been added by the amendments to the claims. The amendments made are not related to patentability and do not alter or limit the substance of the subject matter claimed.

### **IV. Conclusion**

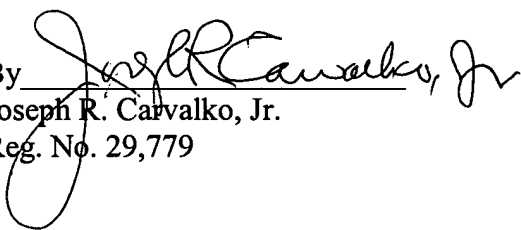
It has been shown that the claimed invention distinguishes over the express and implied teachings of the prior art cited of record in the application, and in particular, distinguishes over the express and implied teachings of Leatherman in view of Johnson. Having addressed the examiner's rejections of the claims under 35 USC §103, applicant submits that the reasons for the examiner's rejection have been overcome and can no longer be sustained. Applicant respectfully requests reconsideration, withdrawal of the rejections and that a Notice of Allowance be issued.

If the examiner believes that unresolved issues associated with this response may be resolved in an expeditious manner, the Examiner is invited to call Applicant's attorney at the telephone number indicated below.

**V. Fees**

No fees are believed necessary for filing this amendment. However, if any fees are deemed needed, the Commissioner for Patents is hereby authorized to charge any additional fees or credit any excess payment that may be associated with this communication to Duane Morris LLP deposit account **50-2061**.

Respectfully submitted,

By   
Joseph R. Carvalko, Jr.  
Reg. No. 29,779

DUANE MORRIS, LLP  
380 Lexington Avenue  
New York, NY 10168  
212.692.1052  
212.692.1020